Question Q217

National Group: Argentina

Title: **The patentability criterion of inventive step / non-obviousness**

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Questions

I. Analysis of current law and case law

The Groups are invited to answer the following questions under their national laws:

Level of inventive step / non-obviousness

1. What is the standard for inventive step / non-obviousness in your jurisdiction? How is it defined?

Section 4 of the Argentine Patent Law (APL) provides a definition of inventive step in the following terms:

> *Inventions of products or processes shall be patentable, provided they are new, involve an inventive step, and have industrial applicability.*
> *…d) There will be inventive step when the creative process or its results cannot be deduced from the state of the art in a way which is evident for a person normally skilled in the pertinent technical field.*

2. Has the standard changed in the last 20 years?
Has the standard evolved with the technical / industrial evolution of your jurisdiction?

Yes, the previous Patent Law (in force until 1995) had a provision whereby the full patent term was granted only if there was sufficient inventive merit, however the standard for inventive merit was not defined in the law but evolved through case law. The standard has now evolved in the sense that it is now defined in the law itself although the level required is generally the same.

3. Does your patent-granting authority publish examination guidelines on inventive step / non-obviousness? If yes, how useful and effective are the guidelines?

Yes, there is an Examination Guidelines called *Directrices sobre Patentamiento* that was prepared by The Argentine Patent Office of the National Institute of Industrial Property and published in the Official Gazette on December 19, 2003.
The Examination Guidelines provides the use of "problem-solution approach" as a general procedure to decide whether an invention involves an inventive step.
The use of this method reduces subjectiveness of the examiner in the way of selection and combination of documents when analysing if there is an inventive step.

4. Does the standard for inventive step / non-obviousness differ during examination versus during litigation or invalidity proceedings?

No, the standard for inventive step is the same both for examination and for litigation.

Construction of claims and interpretation of prior art

5. How are the claims construed in your jurisdiction? Are they read literally, or as would be understood by a person skilled in the art?

Claims consist of two parts: the first is the preamble of the claim which indicates the object to be protected, separated by the expression "characterized by" of the second part, which specifies the new and inventive features of the claimed object.

According to Section 22 of the APL, the claims shall define the invention for which protection is requested, and establish the scope of the right. As they should include the technical characteristics of the invention, they are read and interpreted as would be understood by a person skilled in the art.

6. Is it possible to read embodiments from the body of the specification into the claims?

Claims can be directed to specific embodiments of the specification..

7. How is the prior art interpreted? Is it read literally or interpreted as would be understood by a person skilled in the art? Is reliance on inherent disclosures (aspects of the prior art that are not explicitly mentioned but would be understood to be present by a person skilled in the art) permitted?

According to Section 4, Subparagraph c of the APL, prior art is defined as "*... all technical knowledge which has become public before the date of filing of the patent application, or, if applicable, of the recognized priority, by way of oral or written description, by use, or by any other means of disclosure or information, in the country or abroad."*

Therefore, prior art is interpreted as it would be understood by a person skilled in the art.

Inherent disclosures are considered when examining novelty, as indicated in the Examination Guidelines (Part C, Chapter IV, page 59): "*7.2. A document affects the novelty of any claimed matter of the examined application if it is derived directly and unequivocally form this document, including any characteristic which, for a skilled person in the art, is implicit in which is expressly described in the document."*

8. Do the answers to any of the questions above differ during examination versus during litigation?

The interpretation of prior art is the same both for examination and for litigation.

Combination or modification of prior art

9. Is it proper in your jurisdiction to find lack of inventive step or obviousness over a single prior art reference?

Yes, the examiner may find lack of inventive step or obviousness over a single prior art reference.

If yes, and assuming the claim is novel over the prior art reference, what is required to provide the missing teaching(s)? Is argument sufficient? Is the level of the common general knowledge an issue to be considered?

Argument may not be sufficient. The level of the common general knowledge for a person of average skill in the art is an issue to be considered..

10. What is required to combine two or more prior art references? Is an explicit teaching or motivation to combine required?

No, an explicit teaching or motivation to combine is not required. According to the Examination Guidelines (Part C, Annex II, Page 129), "*the knowledge of a skilled person in the art can sometimes provide the incentive to make something that is not specifically described in a document of the prior art*".

11. When two or more prior art references are combined, how relevant is the closeness of the technical field to what is being claimed?

The closeness of the technical field between what is being claimed and the prior art is relevant.

How relevant is the problem the inventor of the claim in question was trying to solve?

The problem that the inventor of the claim is trying to solve is relevant.

12. Is it permitted in your jurisdiction to combine more than two references to show lack of inventive step or obviousness? Is the standard different from when only two references are combined?

The combination of more than two prior art reference may is allowed (Examination Guidelines Part C, Chapter IV, page 55, item 10.4).

13. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Technical Problem

14. What role, if any, does the technical problem to be solved play in determining inventive step or non-obviousness?

The technical problem determination is the part of the "problem-solution approach", recommended by the Examination Guidelines for evaluating inventiveness (Part C, Chapter

IV, Page 64). Therefore, correctly explaining the technical problem to be solved may be important for demonstrating inventiveness.

15. To what degree, if any, must the technical problem be disclosed or identified in the specification?

The specification may not explicitly disclose the technical problem, but the technical problem must be derivable or deduced form the specification. The Examination Guidelines indicate that "*3.6 If it is determined that an independent claim defines a patentable invention, it must be possible to derive the technical problem from the specification*" (Part C, Chapter II, page 5).

Advantageous effects

16. What role, if any, do advantageous effects play in determining inventive step or non-obviousness?

Advantageous effects are usually positively considered by examiners for demonstrating inventive step. To overcome prior art objections for lack of inventive step or non-obviousness, it would be necessary to demonstrate a surprising (unforeseeable) effect rather than formulating the problem-and-solution test.

17. Must the advantageous effects be disclosed in the as-filed specification?

No, advantageous effects descriptions can be filed later, e.g. when answering an examination office action (Examination Guidelines, Part C, Chapter II, page 4, point 3.3). However, the advantageous effects will be accepted only if they are implicitly disclosed, or at least related to the technical problem originally suggested in the originally filed application Examination Guidelines, Part C, Chapter IV, page 67, point 10.7).

18. Is it possible to have later-submitted data considered by the Examiner?

Yes, but this data is not incorporated in the specification (Examination Guidelines, Part C, Chapter II, page 4, point 3.3).

19. How "real" must the advantageous effects be? Are paper or hypothetical examples sufficient?

Examiners normally require demonstrating advantageous effects by comparative experimental data. Paper or hypothetical examples are usually rejected.

20. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Teaching away

21. Does your jurisdiction recognize teaching away as a factor in favour of inventive step / non-obviousness? Must the teaching be explicit?

Yes, teaching away is a factor in favour of inventive step. Even when the Examination Guidelines suggest that this teaching may not be explicit (Part C, Annex I, page 118, point 4), in the practice examiners sometimes require to demonstrate the teaching away by filing documents disclosing it.

22. Among the other factors supporting inventive step / non-obviousness, how important is teaching away?

If the teaching away is clearly demonstrated, it is an important factor, indeed it is one of the most effective ways of supporting inventiveness.

23. Is there any difference in how teaching away is applied during examination versus in litigation?

No.

Secondary considerations

24. Are secondary considerations recognized in your jurisdiction?

Yes, some secondary considerations are recognised.

25. If yes, what are the accepted secondary considerations? How and to what degree must they be proven? Is a close connection between the *claimed* invention and the secondary considerations required?

Secondary considerations positively considered are, for instance, solving a technical problem which has been tried to be solved for a long time (Examination Guidelines, Part C, Chapter IV, page 67, point 10.6). Commercial success is not considered as a factor for supporting inventiveness (Examination Guidelines, Part C, Chapter IV, page 67, point 10.6). There is not a firmly established criterion regarding the demonstration of these secondary considerations, but normally examiners require filing documents which demonstrate these considerations. However, secondary considerations are not the most effective arguments for supporting inventiveness.

There is not close connection between the claimed invention and the secondary considerations required, i.e. any of the mentioned considerations could be applied to any claimed object.

26. Do the answers to any of the questions above differ during examination versus during litigation?

No.

Other considerations

27. In addition to the subjects discussed in questions 4 - 26 above, are there other issues, tests, or factors that are taken into consideration in determining inventive step / non-obviousness in your jurisdiction?

If yes, please describe these issues, tests, or factors.

No.

Test

28. What is the specific statement of the test for inventive step/non-obviousness in your jurisdiction? Is there jurisprudence or other authoritative literature interpreting the meaning of such test and , if so, provide a brief summary of such interpretation.

The basics of the test are (a) identify the closes prior art, (b) define the technical problem and (c) determine from (a) and (b) whether the solution to the problem would have been obvious

or not to a person skilled in the art. The jurisprudence has not considered the test since it was introduced by the patent office guidelines after the new patent law was enacted.

29. Does such test differ during examination versus during litigation?

No.

Patent granting authorities versus courts

30. If there are areas not already described above where the approach to inventive step / non-obviousness taken during examination diverges from that taken by courts, please describe these areas.

No.

31. Is divergence in approach to inventive step / non-obviousness between the courts and the patent granting authority in your jurisdiction problematic?

As there are few cases-law regarding this issue in Argentina it is difficult to state if there is a divergence approach between the courts and the Patent Office.

Regional and national patent granting authorities

32. If you have two patent granting authorities covering your jurisdiction, do they diverge in their approach to inventive step / non-obviousness?

There is only one Patent Office in Argentina.

33. If yes, is this problematic? --

II. Proposals for harmonization

The Groups are invited to put forward proposals for the adoption of harmonised rules in relation to the patentability criteria for inventive step / non-obviousness. More specifically, the Groups are invited to answer the following questions without regard to their national laws:

34. Is harmonization of inventive step / non-obviousness desirable?

Yes.

35. Is it possible to find a standard for inventive step / non-obviousness that would be universally acceptable?

Yes.

36. Please propose a definition for inventive step / non-obviousness that you would consider to be broadly acceptable.

There will be inventive step when the creative process or its results cannot be deduced from the state of the art in a way which is evident for a person normally skilled in the pertinent technical field.

37. Please propose an approach to the application of this definition that could be used by examiners and by courts in determining inventive step / non-obviousness.

The “problem-solution”, formulation of a new problem, surprising useful effect and overcoming a technical prejudice approaches.

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Note: It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer. If possible type your answers in a different colour. Thank you for your assistance.

Summary

The Argentine Patent system evolved from a very vague notion of inventive step to a more precise definition provided by the Law and the Guidelines issued by the Patent Office.

Today, there will be inventive step when the creative process or its results cannot be deduced from the state of the art in a way which is evident for a person normally skilled in the pertinent technical field.

Argentina adopted the logic of the “Problem-Solution approach” as a way to provide some certainty when determining the existence of inventive step.

The Guidelines of the Patent Office, together with the current practice, allow secondary considerations, advantageous effects and teaching-away tests to show the existence of inventive step.

Résumé

Le system de brevets argentin a évolué d’une vague notion d’activité inventive à une définition plus précise fournie par la Loi et les indications du Bureau des Brevets d’Inventions.

Aujourd’hui il y aura une activité inventive quand le processus créatif ou ses résultats ne peuvent pas être déduits de la technique de pointe de façon qui soit évidente pour une personne qualifie dans le champ technique pertinent.

L’Argentine adopta la logique de « l’approximation problème-solution » de manière à fournir de la certitude dans la détermination de l’existence d’une invention.

Les indications du Bureau des Brevets d’Invention et la pratique actuelle, permettent des considérations secondaires, des effets avantageux et des « teaching-away » tests pour démontrer l’existence d’une invention.

Zusammenfassung

Die Argentinische Patent Anordnung entwickelte von einem sehr unklaren Begriff von erfinderischer Tätigkeit zu einer mehr genauen Feststellung, die durch das Gesetz und vom Patentamt aufgegebene Leitlinien besorgt wurde.

Heutzutage, wird es erfindische Tätigkeit geben wenn das kreative Prozess, oder seine Ergebnisse, nicht durch dem Stand der Technik abgeleitet sein können, in einer Art und Weise die für einer normalerweise ausgebildete Person im entsprechendes technisches Feld offensichtlich ist.

Argentinien übernahm den "Problem - Lösung" (Problem -Solution) Denkansatz wie eine Art und Weise um etwa Sicherheit beizustellen wenn man die Existenz von erfindische Tätigkeit bestimmt.

Die Patentamt Leitlinien, zusammen mit der jetzige Ausübung, gestatten nebensächliche Ausehungen, günstige Ergebnisse und abwesendführungs Teste, um die Existenz der erfindische Tätigkeit zu beweisen.